

REMARKS

Claims 1-42, 45-101 and 103-113 are pending in the present application. Applicants note with appreciation the allowance of claims 37-40 and the indication of allowable subject matter with respect to claims 1-36, 41, 42, 45-101 and 103-113 if the rejection under 35 U.S.C. §112 (second paragraph) is overcome. With entry of this Amendment, Applicants amend claims 1, 7, 13, 19, 25, 31, 37, 39, 41, 45, 50, 55, 61, 67, 69, 71, 77, 83, 85, 87, 93-96 and 103-106. Reexamination and reconsideration are respectfully requested.

Telephone Interview

Applicants note with appreciation the courtesy of the Examiner in conducting a telephone interview with the undersigned on August 1, 2006 to further discuss the Office Action.

The Rejections

The Examiner rejected claims 1-36, 41, 42, 45-101 and 103-113 under § 112 (second paragraph) as discussed above. The Examiner believes that the claims lack definite elements or steps for producing a final product or process of communication between the electronic musical instrument and the portable telephone terminal and are incomplete. The Examiner also found the use of "can" for elements that provide a function to be indefinite.

The analysis below follows in part the order of the claims discussed during the interview.

Claims 41-54, 101, 103 and 104

As discussed during the interview, it is believed that claims 41-54, 101, 103 and 104 should not have been rejected for lacking structural elements or omitting essential elements.

With respect to claims 41 and 42, Applicants note that these claims recite only a portable telephone terminal. They do not recite an electronic musical instrument at all and, thus, are different from the claims relating to an electronic musical instrument and portable telephone terminal that can

be coupled together which the Examiner rejected under § 112 (second paragraph). Thus, claims 41 and 42 should not have been rejected for lacking structural elements or omitting essential elements. Applicants note that claim 41 has been amended to delete “can” relating to the recited communication block. Accordingly, Applicants respectfully submit that claim 41 and dependent claim 42 are in condition for allowance.

Applicants note that claim 101 is directed to a method of operating a portable telephone terminal and, thus, should not have been rejected for omitting essential steps for similar reasons as to claims 41 and 42. Accordingly, Applicants respectfully submit that claim 101 is also in condition for allowance.

With respect to claims 45-54, Applicants note that these claims are directed to a mobile wireless terminal set which can execute remote control over functions of an electronic musical instrument. The claims recite in the preamble the capability of the mobile wireless set and the bodies of the claims recite the elements of the mobile wireless terminal set that provide the capability. Claims 45-54 are thus different from the claims relating to an electronic musical instrument and portable telephone terminal that can be coupled together which the Examiner rejected under § 112 (second paragraph). Moreover, claims 45 and 50 have been amended to delete “can” for certain elements of the mobile wireless terminal set. Accordingly, Applicants respectfully submit that claims 45-54 are in condition for allowance.

Applicants further note that claims 103 and 104 are directed to methods of operating a mobile wireless terminal set for executing remote control functions. They have been amended in a similar manner. For the reasons set forth above, claim 103 and 104 are also in condition for allowance.

Claims 1-36, 55-66, 71-82, 87-98, 105, 106, 109, 110 and 113

Applicants have amended claims 7, 19, 25, 31, 55, 61, 71, 77, 87, 94, 96, 105 and 106 to delete “can” for certain recited elements.

During the interview, the undersigned and the Examiner discussed claims 1-36, 55-66, 71-82, 87-98, 105, 106, 109, 110 and 113 by focusing on claim 1. The Examiner explained his rejection in more detail. He noted that the last element of claim 1 needed clarification to reflect that the music information is transferred from the portable telephone to the public communication network. Applicants have amended claim 1 to recite “for transfer of the music information from the portable telephone terminal to the public communication network.” This amendment has also been made in claims 13, 61, 69, 77, 93, and 95. Thus, this amendment addresses the Examiner’s request for clarification.

The Examiner also noted that the present application is directed in part to the use of an electronic musical instrument with a portable telephone terminal. The Examiner indicated that the preamble in claim 1 recite that the electronic musical instrument “can be” coupled to a portable telephone terminal and thus appears to be inconsistent with how the invention works. (The use of “can” in the bodies of these claims has been addressed as discussed above with respect to the amendment of claims 7, 19, 25, 31, 55, 61, 71, 77, 87, 94, 96, 105 and 106.)

Applicants respectfully submit that claim 1 is directed to an electronic musical element. It recites the elements of the claimed instrument for processing music information and having the capability to be coupled to a portable telephone terminal. Such a capability distinguishes the claimed instrument from other musical instruments which do not have this capability, regardless of whether the portable telephone terminal is attached or not. To provide another example, a claim directed to a printer having computer interface does not need to claim the computer itself. Thus, Applicants respectfully submit that the preamble of claim 1 does not render the claim indefinite nor are any of the claims having the same or similar preamble indefinite.

Applicants note that certain claims in this group – claims 13, 19, 25, 31, 55, 61, 71, 77 and 87 – recited in their bodies a coupling between the electronic musical instrument and the portable telephone terminal. To be consistent with the preamble as discussed, Applicants have amended these claims. For example, claim 13 is directed to an electronic musical instrument and comprises a coupling block. Applicants have amended the recitation “a coupling block that is coupled to the portable telephone terminal” to “a coupling block that is for coupling to the portable

telephone terminal.” As discussed above, there is no need to recite an actual connection. It is noted that claims 67, 69, 83 and 85 have been similarly amended and are discussed in more detail in the next section.

Claims 37-40, 67-70, 83-86, 99, 100, 107, 108, 111 and 112

The Examiner allowed claims 37-40 as discussed above. In the Office Action, the Examiner explained that these claims were allowed, because they recite a system including an electronic musical instrument as well as a portable telephone terminal. (See Office Action at page 3, last paragraph.)

As discussed during the interview, Applicants respectfully submit that there are other claims – claims 67-70 and 83-86 – directed to a system comprising an electronic musical instrument and a portable telephone terminal. Based on the Examiner’s reasoning with respect to claims 37-40, claims 67-70 and 83-86 should not have been rejected for lacking structural elements or omitting essential elements.

Applicants note that independent claims 37, 39, 67, 69, 83 and 85 have been amended to delete “can” for certain elements of the electronic musical instrument or portable telephone terminal that perform a function. For example, in claim 37, “a communication block that can communicate” has been amended to “a communication block for communicating” Or, in claim 39, “a main block that can process” has been amended to “a main block that processes. . . .”

Applicants note that claims 67, 69, 83 and 85 recite elements of the system (as opposed to elements of an instrument or terminal) that are capable of connection or communication. For example, claim 67 recites “a portable telephone terminal that can be coupled to the electronic musical instrument.” Claiming a portable telephone having such a capability is not indefinite as discussed above.

Accordingly, Applicants respectfully submit that claims 67-70 and 83-86 are in condition for allowance.

Applicants further note that claims 99, 100, 107, 108, 111 and 112 are directed to methods of operating a system. Based on the Examiner's reasoning with respect to claims 37-40, claims 99, 100, 107, 108, 111 and 112 should not have been rejected for omitting essential steps. Accordingly, Applicants respectfully submit that these claims are also in condition for allowance.

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-42, 45-101 and 103-111 of the present application are in condition for allowance. If, for any reason, the Examiner finds the application other than in condition for allowance, Applicants request that the Examiner contact the undersigned attorney at the Los Angeles telephone number (213) 892-5630 to discuss any steps necessary to place the application in condition for allowance.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 393032020500.

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Respectfully submitted,

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